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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/767,615 | 01/30/2004 | Hidehiko Ogawa | P24497 | 5644 |
| 7055 | 7590 | 06/30/2005 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | LEE, TOMMY D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,615

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 and 29-34 is/are allowed.
- 6) ☒ Claim(s) 16-20, 27, 28, 35, 36, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 21-28 and 37-44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050228.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's amendment filed February 28, 2005. Claims 1-44 are pending.

Claim Objections

2. Claims 21-28 and 37-44 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 5, 6, 10, 11, 15, 16, 20 and 29-36, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 16-20, 27, 28, 35, 36, 43 and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of

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U.S. Patent No. 6,710,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the pending apparatus claims 16-20 and method claims 35-36 of the application and the allowed claims of the patent is that a memory in the application is configured to store a mail address of at least one user as well as information regarding the user's identification, whereas the memory in the patent just stores the user's identification information. However, adding a mail address to a name of a user is a well-known means for providing a second piece of information regarding the sender of image information. Senders of regular mail and facsimile transmission regularly include a name *and* an address or fax number identifying him/herself to a recipient. In an e-mail communication, it would be equally obvious for one of ordinary skill to provide both types of information, so that a recipient can identify the sender. Since a memory for storing identification of a user is claimed in the patent, it would have been obvious for one of ordinary skill in the art to modify such memory to include the mail address as well, so that both pieces of information may be accessed without the sender having to type in the information. Furthermore, regarding pending claims 27-28 and 43-44, these claims further recite a transmitter (claim 27) or corresponding transmission step (claim 43), which reads on lines 2-6 of patent claim 1 and lines 3-4 of patent claim 5, respectively.

Allowable Subject Matter

5. Claims 1-15 and 29-34 are allowed.

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6. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest “a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus,” as recited in base claim 1 and similarly recited in base 29; or “a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and a reply to the e-mail can be sent to the user without requiring input of the mail address of the user at the receiving apparatus, the reply being sent from the receiving apparatus,” as recited in base claim 6 and similarly recited in base claim 31; or “a controller configured to set the information regarding the identification of the user and the mail address of the user selected by the panel section, into the mail message of the e-mail to which the image data is attached, whereby opening, at the receiving apparatus, of the attached image data is not required to determine the information regarding the identification of the user, and a reply to the e-

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mail is returned to the mail address of the user,” as recited in base claim 11 and similarly recited in base claim 33.

Response to Arguments

7. Applicant's arguments, see page 19, line 13 – page 24, line 13 of applicant's remarks, filed February 28, 2005, with respect to the rejection(s) of claim(s) 16-20, 27, 28, 35, 36, 43 and 44 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent 6,710,894 (note Double Patenting rejection above). It should be noted the new grounds of rejection are necessitated by claim amendments made by applicant in response to the prior rejection.

8. Applicant's arguments filed in response to the objection of claims 21-28 and 37-44 as set forth in the prior Office action have been fully considered but they are not persuasive. Applicant asserts that, for example, claim 1 does not positively recite the transmitter recited in claim 21, and is thus not a duplicate or “so close in content” to claim 1 (page 19, lines 5-12 of applicant's remarks). Contrary to applicant's assertion, claim 1 recites “transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data attached to the e-mail as an openable document” at lines 2-5 of the claim. The transmitting step requires the presence of a transmitter. Thus, the limitation is at least “so close in content” to the transmitter recited in claim 21, and the objection is maintained. The remaining claims above remain objected-to for similar reasons.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
June 22, 2005